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Docket No. PGR-100
Serial No. 09/759,423Remarks

Claims 1-12 and 21-22 were pending in the subject application. By way of this Amendment, new claim 38 has been added. Accordingly, claims 1-12, 21-22, and 38 are now before the Examiner. The undersigned avers no new matter has been added by this Amendment. Favorable consideration of the pending claims is earnestly requested.

Claims 1-2 and 21-22 have been rejected under 35 U.S.C. §103(a) as being unpatentable over Sweetland (U.S. Patent No. 3,345,037) in view of Linton *et al.* (U.S. Patent No. 4,176,824). The applicant respectfully traverses this grounds for rejection. A *prima facie* case of obviousness has not been presented. Three criteria must be met to establish *prima facie* case of obviousness. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference. Second, there must be a reasonable expectation of success. Finally, the prior art reference, or combination of references, must teach or suggest all the claim limitations. Applicant respectfully traverses the rejection since the prior art does not provide any suggestion or motivation to modify the Sweetland to arrive at the subject invention as claimed in claims 1-12 and 21-22, and there is no reasonable expectation of success of such a modification.

The Office Action dated October 22, 2003 states "[t]o employ in Sweetland a first piece mounted to the vehicle and a second piece mounted to the vehicle jack would have been obvious for one skilled in the art at the time the invention was made in view of the disclosure of Linton" (underline added for emphasis). However, claim 1 incorporates the limitation "a first piece mountable to an A-frame coupler of a trailer" (underline added for emphasis). Submitted herewith is an unsigned Declaration Under 37 CFR §1.132 by Mr. E. Paul Green. Applicant will provide the executed Declaration to the Examiner under separate cover. Referring to page 2, first full paragraph of Mr. Green's Declaration, Mr. Green states,

"the Linton *et al.* reference does not teach a first piece mounted to an A-frame coupler of a trailer. Furthermore, the Office Action does not provide any indication where or how to employ in Sweetland a first piece mounted to an A-frame coupler of a trailer and a second piece mounted to a trailer jack, or how to movably connect the

first piece to the second piece such that the second piece can transition between a plurality of positions relative to the first piece.”

Accordingly, the applicant asserts that there is no motivation to modify the Sweetland reference as stated in the Office Action and there is no reasonable expectation of success of such a modification.

The Office Action states that “one of ordinary skill in the art would have been motivated to do this in order to enable the A-frame mounted jack of Sweetland to be able to transition between a plurality of vehicle positions such that the jack will be initially positioned at a correct vertical position relative to the ground before jacking is begun”. However, referring to page 2, second full paragraph of Mr. Green’s Declaration, Mr. Green states

“the supporting device 13 taught in the Sweetland reference incorporates a “supporting flange 38 rigidly mounted to the shaft ... [i]mmediately above flange 38 is a cylindrical bushing 39, also rigidly attached to the shaft ... [b]elow flange 38 is another bushing 40 spaced from the flange and also rigidly attached to shaft 30” (see column 2, lines 54-58). The Sweetland reference teaches “[i]n operation, yoke A is held at an elevation wherein the shaft 30, in the areas above bushing 39 and 40, can fit through mouths 43 and 44 into keyways 25 and 26; in the aforesaid position, shaft 30 is maintained in vertical alignment ... [y]oke A is then lowered wherein plate 13 at the area adjacent keyway 25 rests upon flange 38 to support the yoke” (see column 2, lines 66-72). Accordingly, the Sweetland reference relies on keyway 25 resting upon flange 38 to support the yoke, such that the mounting of the second piece 32 taught by Linton to the trailer jack (supporting device B) taught by Sweetland and the mounting of the first piece 38 taught by Linton to the A-frame coupler of the trailer taught by Sweetland would not function to allow the trailer jack (supporting device B) mounted to the second piece to transition between a plurality of positions relative to the trailer mounted to the first piece without defeating the mechanism the Sweetland reference relies on to support the yoke, namely keyway 25 resting upon flange 38. In fact, the Sweetland reference teaches, as column 1, lines 35-36, “it is obvious that the yoke support must be removed when the trailer is again connected to a pulling vehicle” and, at column 1, lines 36-44, “[i]t is a principal object of the

invention to provide a support removeably engageable with the yoke ..." (underline added for emphasis). Therefore, the Sweetland reference teaches removing the supporting device B when the trailer is connected to a pulling vehicle. Thus, the applicant asserts that one of ordinary skill in the art would not have been motivated to employ in Sweetland a first piece mounted to an A-frame and a second piece mounted to the trailer jack."

Accordingly, the applicant respectfully requests reconsideration and withdrawal of the rejection of claims 1-2 and 21-22 under 35 U.S.C. §103(a).

On page 3, fifth full paragraph, third sentence of the Office Action, the Examiner states "Applicant's remarks that the Linton *et al.* jack mounting arrangement would not function in a trailer is certainly found to have absolutely no merit". The applicant does not know to which remarks the Examiner is referring.

The Office Action continues onto page 4 to state "Applicant presents a long discussion about the Sweetland 'keyway' and 'flange'. ... (t)his entire discussion is found to be irrelevant because the Sweetland structure has been substituted by the Linton *et al.* structure". Referring to page 3, first full paragraph of the Green Declaration, Mr. Green states

"The reason the applicant's prior remarks discuss the Sweetland "keyway" and "flange" is because that is the mechanism which enables the Sweetland jack to be removeably engageable with the yoke, which is the principle object of the Sweetland invention (see column 1, lines 36-44). On page six, the Office Action states that "applicant further argues that purpose of the Sweetland reference is defeated by modifying the jack mounting arrangement in the manner taught by Linton *et al.* ... [t]he primary purpose of the jack in Sweetland is for raising the vehicle so the purpose of the jack in Sweetland indeed has not been defeated by the Linton *et al.* modification", the invention taught in the Sweetland reference is a removable trailer support (see title, column 1, lines 11-13, 21-23, 34-36, 41-42, 48-50, and 58-61), rather than a jack. Sweetland teaches at column 2, lines 5-7, "the device to be easily installed and removed without the necessity for tools and special equipment". With regard to a jack, Sweetland teaches "a jack assembly in combination with the trailer

support” such that the jack is an accessory to be used in combination with the removable trailer support, rather than the jack being the invention. Accordingly, the intended purpose of the Sweetland device would be defeated by modifying the Sweetland device in the manner suggested by the Office Action by incorporating a first piece and second piece from Linton *et al.*, if such a modification could even function.”

Moreover, “if a proposed modification would render the prior art invention being modified unsatisfactory for its intended purpose, then there is no suggestion or motivation to make the proposed modification”. *In re Gordon*, 733 F.2d 900, 221 USPQ 1125 (Fed. Cir. 1984). Referring to page 4, carry over paragraph, last sentence of the Green Declaration, Mr. Green states

“the modification proposed by the Office Action would render the Sweetland device unsatisfactory for its intended purpose, namely to be a support removably engageable with the yoke of a trailer (column 1, line 37-39).”

Therefore, there is no suggestion or motivation to make the modification proposed in the Office Action.

In addition, “if a proposed modification or combination of the prior art would change the principle of operation of the prior art invention being modified, then the teachings of the references are not sufficient to render the claims *prima facie* obvious”. *In re Ratti*, 270 F.2d 810, 123 USPQ 349 (CCPA 1959). Referring to page 4, first full paragraph, of the Green Declaration, Mr. Green states

“the modification proposed in the Office Action would change the principle of operation of the Sweetland device, namely to be a support removably engageable with the yoke of a trailer (column 1, line 37-39) with respect to which the Sweetland reference teaches “[i]n operation, yoke A is held at an elevation wherein the shaft 30, in the areas above bushing 39 and 40, can fit through mouths 43 and 44 into keyways 25 and 26; in the aforesaid position, shaft 30 is maintained in vertical alignment ... [y]oke A is then lowered wherein plate 13 at the area adjacent keyway 25 rests upon flange 38 to support the yoke” (see column 2, lines 66-72).”

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Therefore, the teachings of the Sweetland and Linton *et al.* references are not sufficient to render the rejected claims *prima facie* obvious.

The statement on page 4 of the Office Action that “[i]n any case, the elimination of a feature with the consequent loss of function (*i.e.*, the removability of the jack) is an indication of obviousness” is confusing. With the exception of the reference to the loss of the removability of the jack (if the Sweetland device could be modified with the Linton *et al.* apparatus) the applicant is not sure to what the Office Action is referring, making it difficult to reply.

The Office Action then states “applicant is merely claiming a first piece and a second piece, whereby the first and second pieces can transition between a plurality of positions.” Referring to page 4, second full paragraph of the Green Declaration, Mr. Green states

“This is not true. Claim 1 is directed to a trailer jack mounting apparatus comprising: a first piece mountable to an A-frame coupler of a trailer; and a second piece mountable to a trailer jack. ... There is no suggestion in the Office Action of how the Linton *et al.* apparatus could be mounted to an A-frame coupler. Claim 21 provides a further limitation “wherein the A-frame coupler is designed to have the trailer jack mounted to the A-frame coupler”. There is no suggestion in the Office Action of how the Linton *et al.* apparatus could be mounted to an A-frame coupler designed to have the trailer jack mounted to the A-frame coupler. Claim 22 provides a further limitation “wherein the trailer jack is designed to mount to the A-frame coupler of the trailer”. There is no showing in Linton *et al.* of a second piece mountable to a trailer jack, wherein the trailer jack is designed to mount to the A-frame coupler of the trailer.”

Accordingly, a *prima facie* case of obviousness has not been presented with respect to claim 1-2 and 21-22. Therefore, the applicant respectfully requests reconsideration and withdrawal of the rejection of claims 1-2 and 21-22 under 35 U.S.C. §103(a).

Claims 3-12 have been rejected under 35 U.S.C. §103(a) as being unpatentable over Sweetland in view of Linton *et al.* taken with Ebey (U.S. Patent No. 4,623,125). Referring to page 4, third full paragraph of the Green Declaration, Mr. Green states

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"The deficiencies with respect to the rejection of claims 1-2 and 21-22 over Sweetland *et al.* in view of Linton *et al.* have been discussed above. The Ebey reference does not cure such defects. Furthermore, claim 4 includes the limitation "wherein said first piece comprises a trailer mounting structure for mounting to the A-frame coupler of the trailer and at least one extending structure for pivotally connecting to said second piece, wherein said second piece comprises a trailer jack mounting structure for mounting to the trailer jack and at least one pivoting arm for pivotally connecting to said first piece,... Claim 9 includes the limitation "wherein said first piece is removably mounted to the A-frame coupler of the trailer. The applicant asserts that the Sweetland, Linton *et al.*, and Ebey references, alone or in combination, do not teach or suggest the subject invention as claimed in claims 4 and 9 and, in particular, the underlined limitations."

Accordingly, a *prima facie* case of obviousness has not been presented with respect to claim 3-12. Therefore, the applicant respectfully requests reconsideration and withdrawal of the rejection of claims 3-12 under 35 U.S.C. §103(a).

Applicant wishes to thank the Examiner for consideration of the remarks submitted in the applicant's Response dated January 22, 2004, with respect to which the Examiner provided an Advisory Action dated February 4, 2004. The Advisory Action states that "applicant is not claiming the A-frame of a trailer hence it is no more than a matter of intended use that has no patentable significance as to what the jack is ultimately mounted to." The applicant refers to the above discussion of the limitations of claims 1, 4, 9, 21, and 22, namely: claim 1 incorporates the limitations a first piece mountable to an A-frame coupler of a trailer; and a second piece mountable to a trailer jack; claim 21 provides a further limitation "wherein the A-frame coupler is designed to have the trailer jack mounted to the A-frame coupler"; claim 22 provides a further limitation "wherein the trailer jack is designed to mount to the A-frame coupler of the trailer"; claim 4 includes the limitation "wherein said first piece comprises a trailer mounting structure for mounting to the A-frame coupler of the trailer and at least one extending structure for pivotally connecting to said second piece, wherein said second piece comprises a trailer jack mounting structure for mounting to the trailer jack and at least one pivoting arm for pivotally connecting to said first piece, ...; and claim

9 includes the limitation "wherein said first piece is removably mounted to the A-frame coupler of the trailer". The applicant asserts that arguments directed to these limitations, and others, are not arguments regarding intended use, but, rather, arguments regarding limitations of the subject invention as claimed.

The Advisory Action states "applicant further argues that some of the structure in Linton *et al.* is not 'removably mounted'... it is the Examiner's position that all elements can obviously be removed in the reverse manner from which they were assembled." However, the Sweetland reference teaches, as the invention, a support removably engageable with the yoke and, at column 2, line 5-7, teaches "the device to be easily installed and removed without the necessity for tools and special equipment." The applicant asserts the principal object of the Sweetland invention is to allow a user to engage and remove the support (jack) with/from the yoke without tools or special equipment once the "keyway" and "flange" are installed. In contrast, the Linton reference teaches bails 40 which "encircle the device 14 so that the latter may be retained by the fixture." (see column 1, lines 55-59). Accordingly, the Linton reference does not teach or suggest a removably engageable support.

The Advisory Action states "if the proposed combination were not removable from the Sweetland A-frame this would not defeat the principle purpose of the Sweetland jack, *i.e.*, to lift a trailer A-frame." Again, the Sweetland reference does not teach a jack, but, rather, teaches a removably engageable support. In fact, the main embodiment taught in Sweetland does not even incorporate a jack. Column 3, lines 49-51 of Sweetland teaches "as an alternative in the embodiment of the invention, as shown in Figure 7, a jack mechanism can be employed in combination with shafts 30 or 65.

Finally, the Advisory Action states "applicant is merely claiming a first piece connected to a second piece whereby the first and second pieces can transition between a plurality of [positions?] which is exactly what Linton *et al.* shows." The applicant strongly disagrees with this statement and refers to the above discussed limitations of claims 1, 4, 9, 21, and 22, as well as other limitations of these claims and of the remaining claims.

In view of the foregoing remarks and amendments to the claims, the applicant believes that the currently pending claims are in condition for allowance, and such action is respectfully requested.

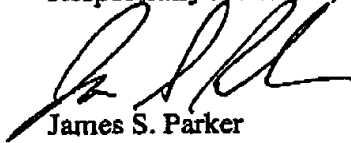
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The Commissioner is hereby authorized to charge any fees under 37 CFR 1.16 or 1.17 as required by this paper to Deposit Account 19-0065.

Applicant invites the Examiner to call the undersigned if clarification is needed on any aspect of this response, or if the Examiner believes there remains any valid ground upon which any claim in this application may be rejected subsequent to entrance of this amendment.

Respectfully submitted,



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